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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/792,238	03/02/2004	Kevin M. Lewandowski	59520US002	4771
32692	7590	11/16/2006		
3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427				
			EXAMINER SILVERMAN, ERIC E	
			ART UNIT 1615	PAPER NUMBER

DATE MAILED: 11/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/792,238	<b>Applicant(s)</b> LEWANDOWSKI ET AL.	
	<b>Examiner</b> Eric E. Silverman, PhD	<b>Art Unit</b> 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                               | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                      | 5) <input type="checkbox"/> Notice of Informal Patent Application                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

### DETAILED ACTION

Applicant is advised that the Examiner assigned to this Application has changed. The Examiner currently assigned to this Application is **Eric Silverman, PhD**, whose contact information can be found at the end of this action. Applicant is further advised that this Application is currently assigned to **Art Unit 1615**.

Claims 1 – 31 are pending in this action.

### *Response to Arguments*

In response to Applicants' arguments, all of the rejections articulated in the Office Action mailed 4/6/2006 are **withdrawn**.

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 – 24 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 – 23 of U.S. Patent No.

7,074,839. Although the conflicting claims are not identical, they are not patentably distinct from each other because while the first oligomer of instant claims has pendant polymerizable groups, that of copending claims has pendant photoinitiator groups. Photoinitiator groups are a species of polymerizable groups, in that photoinitiators initiate a polymerization, thus taking part in the polymerization. Copending claims thus recite a species of instant claims, rendering instant claims obvious in their entirety.

Claims 1 – 34 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 – 34 of copending Application No. 10/672,580. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims overlap in that instant hydrophilic (poly(alkylene oxide) cross linking agent is merely a subgenus of copending second component oligomer. Furthermore, copending claim 20 suggests the use of poly(alkylene oxide) second component oligomers, which would be equivalent to instant cross-linking agents. Note that copending second component oligomers are claimed to be polyfunctional, and thus would serve as cross linkers.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1 – 34 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 – 45 of copending Application No. 10/732,715. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims overlap in that instant hydrophilic (poly(alkylene oxide) cross linking agent is merely a subgenus of

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compending second component oligomer. Furthermore, compending claim 16 suggests the use of poly(alkylene oxide) second component oligomers, which would be equivalent to instant cross-linking agents. Note that compending second component oligomers are claimed to be polyfunctional, and thus would serve as cross linkers.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicant is advised that should claim 5 be found allowable, claim 6 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). Note that the difference between these claims is only that claim 5 recites "average degree of polymerization" and that claim 6 recites "degree of polymerization". However, in the polymer art, a degree of polymerization always refers to an average degree of polymerization, since synthetic polymers, even those prepared by "controlled" processes, are necessarily polydisperse. Thus, there is no difference in scope between these two claims. For evidence of Examiners' assertion regarding the term degree of polymerization, see the Odian reference cited on PTO 892.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4, 5, 6, 15, 18, 19, 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2 and 19 recite "residual content" or "residuals content". It is not clear what material or materials are referred to, that is, what material must be present in the amounts specified. It is not clear what a "residual" or "residuals" refers to.

Claims 5 recites "degree of polymerization". The molecular weight of polymers can only be referred to in terms of average molecular weight. See Odian reference cited in PTO 892. It is also unclear if the degree of polymerization refers to the oligomer as a whole or of the poly alkylene oxide group.

Claim 6, 15 and 22 recite "average degree of polymerization". However, there are several different types of average molecular weight, including weight average, number average, Z average, viscosity average, Z+1 average, and so on. It is not clear which of these Applicants are referring to. See Odian reference cited in PTO 892. It is also unclear if the degree of polymerization refers to the oligomer as a whole or of the poly alkylene oxide group.

Claim 18 recites "partially converted to a coatable viscosity". It is unclear how a composition can be partially converted to a viscosity, since viscosity is a property of the composition. The composition either has a particular viscosity or it does not have that viscosity; a composition cannot "partially" have a viscosity.

***Claim Rejections - 35 USC § 102***

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(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 – 31 are rejected under 35 U.S.C. 102(a) or 102(e) as being anticipated by WO 03/086493, of record (WO).

The WO reference teaches a gel material and wound dressings including the same. The gel material is made from a multifunctional poly(alkylene oxide) macromer having molecular weights that correspond to degrees of polymerization of less than 300 (table 4, page 12). The PAO macromer can be a copolymer of PEG and poly propylene glycol (structure on page 4, page 10, lines 9 – 10), and is included in amounts commensurate with those of instant claims (page 4 – 5). The macromers have polymerizable pendant groups that include those of instant claims (pages 5 – 7). These macromers meet the requirements of the “first component” of instant claims, since they comprise polymerized poly propylene glycol units having attached thereto (“pendant”) poly(alkylene oxide) groups (the PEG of the art) and further having attached (“pendant” polymerizable groups. Some of the disclosed polymerizable groups are capable as serving as photoinitiators, thus meeting the limitation of claims requiring same. It is understood that the photoinitiator will be included separately if it is not attached to the polymers (claim 50). Some of the multifunctional initiator may be difunctional (page 11), and as such, will act as a cross-linking agent. Since the multifunctional initiator acts as a cross-linking agent, and meets the structural components of the cross-linkers of instant

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claims in that it comprises poly(alkylene oxide) and has the formula of claim 2 (in some embodiments – see pages 5 – 7 and Formula III on page 15), the multifunctional initiators of the art meet the limitations of the crosslinking agent of instant claims. The amount of such agent used is also disclosed, and is commensurate with instant claims (page 16). The gel can be used in a wound dressing, which has adhesives, is transparent, and has a backing layer (patterning), as required by instant claims 25 - 31. See claims 35 – 38 in the prior art. A method of making the gel and wound dressing is also disclosed (claims 39 – 40 of the art).

### ***Conclusion***


No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric E. Silverman, PhD whose telephone number is 571 272 5549. The examiner can normally be reached on Monday to Friday 7:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on 571 272 8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Eric E. Silverman, PhD  
Art Unit 1615

  
MICHAEL P. WOODWARD  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600